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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,325	10/17/2003	Robert M. Davis	2760-057	3000

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EXAMINER

RODRIGUEZ, JOSEPH C

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/688,325	Applicant(s) DAVIS ET AL.	
	Examiner Joseph C. Rodriguez	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/17/03</u> | 6) <input type="checkbox"/> Other: ____ |

[Handwritten signature]

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for varying an angle of inclination of the inclined trough must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Claim Objections

The claims are objected to as the form of claims 34, 35 and 39 is improper.

Where a claim sets forth a plurality of elements or steps, as in the instant claims, each element or step should be separated by a line indentation. See MPEP 608.01(m) and 37 CFR 1.75(i).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Here, Applicant's Terminal Disclaimer submitted 10/17/03 has been noted and is currently being processed.

In the interim and due to other applicable patents, claims 34-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-21 of U.S. Patent No. 6,648,145 B2 or claims 1-21 of U.S. Patent No. 6,460,706 B1. Although the conflicting claims are not identical, they are not

patentably distinct from each other as the instant claims 34-41 are merely broader versions of the previously issued claims. Moreover, Applicant has ample reason to obtain broader claim coverage, thus it would be obvious to modify the claims as currently presented by Applicant.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 38 recites the limitation "the inclined trough" (last ln.). There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 44, the language "can be" in claim 44 (ln. 3 from end) may render the claims indefinite as it is unclear whether the features subsequent to the "can be" language are a necessary part of the claimed invention. Applicant must positively recite the features of the claimed invention. Examiner thus recommends eliminating all instances of "can be" from the claim language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-24, 26-30 and 32-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindberg (US 4,377,474).

Lindberg teaches a disc screen (Fig. 1-4) comprising a frame (31); a plurality of shafts (47' and "); a plurality of discs (38) mounted on the shafts; means for rotatably supporting the shafts (Fig. 1, 2 showing shaft bearings) on the frame so that the discs of adjacent shafts are interleaved and define a laterally inclined trough (pair of four inner shafts 47'; col. 2, ln. 21-40) a pair of vertically inclined regions (outer shafts 47'") extending from opposite sides of the trough (Fig. 2); and drive means (40) connected to the shafts for rotating the shafts in opposite direction (col. 2, ln 20-30). Lindberg also teaches means for varying the angle of inclination of the inclined regions (col. 2, ln. 10-21) and of the trough (Id.; col. 2, ln. 45-53).

Further, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the disc screen described above is certainly capable of, inter alia, agitating mixed recyclable material so that mixed recyclable materials deposited on the trough will be divided into streams passing through the discs, over the upper ends of the inclined regions, and off a lower end of the trough. Applicant is also respectfully reminded that the material or article (i.e., mixed recyclables, broken glass,

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newspapers) worked upon by the apparatus does not limit apparatus claims. See MPEP 2115.

Further, Examiner requests clarification on whether Applicant is invoking 35 USC 112, sixth paragraph when using "means for" as claim language (See e.g., claim 22). This clarification is required for proper examination of the claims. Further, unless Applicant clarifies the record, Examiner assumes 35 USC 112, sixth paragraph has not been invoked and Examiner will not be limited by the teachings of the specification when interpreting the "means for" claim language. See MPEP 2181.

Claims 22, 24, 26-28, 30, 32-36 and 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Bielagus (US 4,755,286).

Bielagus teaches a disc screen (Fig. 1-3) comprising a frame (23); a plurality of shafts (28); a plurality of discs (26) mounted on the shafts; means for rotatably supporting the shafts (col. 3, ln. 29-39 describing shaft bearings) on the frame so that the discs of adjacent shafts are interleaved and define a laterally inclined trough (shafts in middle) and a pair of vertically inclined regions extending from opposite sides of the trough (Fig. 3, shafts outside of middle); and drive means (30, 31) connected to the shafts for rotating the shafts in opposite direction (col. 3, ln 20-30). Bielagus also teaches varying the angle of incline for the shafts, thus it is implicit that a means of varying the angle of inclination of the inclined regions is taught (col. 3, ln. 45-52).

Further, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight

as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the disc screen described above is certainly capable of, inter alia, agitating mixed recyclable material so that mixed recyclable materials deposited on the trough will be divided into streams passing through the discs, over the upper ends of the inclined regions, and off a lower end of the trough. Applicant is also respectfully reminded that the material or article (i.e., mixed recyclables, broken glass, newspapers) worked upon by the apparatus does not limit apparatus claims. See MPEP 2115.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielagus in view of Kobayashi (US 5,480,034).

Bielagus as set forth above teaches all that is claimed except for expressly teaching a means for blowing air against the inclined regions. Kobayashi, however, teaches a disc screen with a means for blowing against an inclined surface (Fig. 9, blowers 45, 46). Moreover, Kobayashi teaches that the blower means aids separation by helping push the materials to be separated up the inclined disk screen surface (col. 7, ln. 10 et seq.). Therefore, it would have been obvious at the time the invention was

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made to a person having ordinary skill in the art to modify the invention of Bielagus as taught above to aid in distributing the materials for separation.

Claims 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielagus in view of Tirschler (US 5,287,977).

Bielagus as set forth above teaches all that is claimed except for expressly teaching a hollow shaft end with a resilient deformable plug with a stub shaft inserted in the hollow interior of said plug and journaled into a bearing assembly. Tirschler, however, teaches a disc screen with this shaft end feature (Fig. 1, 3, with hollow shaft end near 33 plug 35 stub shaft 1 and bearing assembly shown at top part of fig. 1). Moreover, Tirschler teaches that this feature allows for easier replacement of the disc screen shafts (col. 1, ln. 45-68). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Bielagus as taught above.

Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

<http://pair-direct.uspto.gov>

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **571-272-6584**. Further, the supervisor's contact information is Donald Walsh, 571-272-6944.

Signed by Examiner Joseph Rodriguez

Jcr

June 30, 2005

